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DEC 08 2008

In re Application of
Christophe Bonny
Application No. 10/500,804
Filed: January 7, 2005
Attorney Docket No. 067802-5012-01

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DECISION ON PETITION

This is a decision on the "PETITION UNDER 37 C.F.R. 1.78(a)(3) and 1.78(a)(6), filed May 16, 2008, to accept an unintentionally delayed claim under 35 U.S.C. 120 and 119(e) for the benefit of priority to application PCT/1B03/00332 and provisional application no. 60/347,062.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in 37 CFR 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not satisfy requirement (1) above.

The reference to add the above-noted, prior-filed applications on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application (See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 272 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b)).

In view of the above, the amendment is not acceptable. Accordingly, a substitute amendment along with a renewed petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be submitted.

Receipt of the \$1,410 petition fee is acknowledged.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 PO Box 1450
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By fax: (571)273-8300
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Any inquiries concerning this decision may be directed to Petitions Attorney Cliff Congo at 571-272-3207.



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